Remarks

Claim 1 is currently the only pending claim in this application. By the present Amendment, claims 2 and 3 have been cancelled in favor of claim 1, which has been amended to include the recitations of claims 2 and 3 and to more distinctly define the present invention. It is submitted no new matter has been added to the application.

I. 35 USC §112 Claim Rejections

Claim 1 stands rejected under 35 USC §112, second paragraph, because it was unclear to the examiner whether the recitation "the remote e-mail forwarding computer" of line 2 and "the remote computer" of line 8, 10 and 11 were referring to the "remote e-mail correcting computer" recited in the preamble. Since each instance of "the remote e-mail forwarding computer" and "the remote computer" do indeed refer back to the "remote e-mail correcting computer", each aforesaid recitation has been changed to "said remote e-mail correcting computer" in independent claim 1. Accordingly, this 35 USC §112 rejection has been overcome and withdrawal thereof is warranted.

II. Double Patenting Rejection

Claims 1 and 2 were provisionally rejected under 35 USC §101 as claiming the same invention as that of claims 20 and 21 of co-pending Application No. 09/750,952. Claim 3 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of co-pending Application No. 09/750,952.

As mentioned above, claims 2 and 3 have been cancelled without prejudice and their respective recitations have been incorporated into independent claim 1, thus a Terminal Disclaimer under 37 CFR §1.321 is filed herewith for claim 1 in view of co-pending Application No. 09/750,952. Accordingly, the subject double patenting rejections have each been overcome and withdrawal thereof is warranted.

III. **35 USC §103 CLAIM REJECTIONS**

Claims 1-3 stand rejected under 35 USC §103 as being obvious over U.S. Patent No. 6,654,779 to Tsuei (the "Tsuei patent") in view of U.S. Patent No. 6,427,164 to Reilly (the "Reilly patent").

As mentioned above, by the present Amendment, claims 2 and 3 have been cancelled without prejudice in favor of claim 1, thus the rejection with respect to claims 2 and 3 is now moot and withdrawal thereof is warranted.

With respect to claim 1, it is directed to "A method for correcting an e-mail message that has been determined as being undeliverable via a remote e-mail correcting computer . . ." comprising the steps of inter alia:

> prescribing at least one domain name e-mail address without having an e-mail username . . .;
>
> prescribing at least one e-mail address format message for e-mail messages intended to be sent to the at least one domain name e-mail address;
>
> . . . parsing the intended e-mail address from the undeliverable e-mail message in said remote e-mail correcting computer to determine if the domain name address of the undeliverable e-mail message has been prescribed with said remote e-mail correcting computer;
>
> . . . sending a message to the user's computer containing the prescribed at least one e-mail address format message for the parsed domain name address if the parsed domain name address from said undeliverable e-mail message has been prescribed with said remote e-mail correcting computer.

Thus, the present claimed invention relates to method for correcting undeliverable e-mail addresses whereby a system subscriber "prescribes at least one domain e-mail address without a e-mail username [e.g., @pb.com]. . . [and also] "prescrib[es] at least one e-mail address format message

> [e.g., THE FORMAT FOR USERNAMES RESIDING AT PB.COM IS TO USE THE FIRST SIX CHARACTERS OF THE LAST NAME FOLLOWED FOLLWED IMMEDIATELY BY THE FIRST TWO CHARACTERS OF THE FIRST NAME – FOR EXAMPLE: MR. TOM WATSON WOULD BE WASTONTO@PB.COM - TRY TO REFORMAT THE USERNAME IN ACCORDANCE WITH THIS FORMAT]

for e-mail messages intended to be sent to the at least one domain name e-mail address." When the remote e-mail correcting computer receives from a user's computer an undeliverable e-mail message, the remote e-mail correcting computer "pars[es] the intended e-mail address from the undeliverable e-mail message . . . to determine if the domain name address [e.g., @pb.com] of the undeliverable e-mail address has been prescribed with said remote e-mail correcting computer." And if yes, the remote e-mail correcting computer "send[s] a message to the senders computer containing the prescribed at least one e-mail address format message

> (e.g., THE FORMAT FOR USERNAMES RESIDING AT PB.COM IS TO USE THE FIRST SIX CHARACTERS OF THE LAST NAME FOLLOWED FOLLWED IMMEDIATELY BY THE FIRST TWO CHARACTERS OF THE FIRST NAME – FOR EXAMPLE: MR. TOM WATSON WOULD BE WASTONTO@PB.COM - TRY TO REFORMAT THE USERNAME IN ACCORDANCE WITH THIS FORMAT)

for the parsed domain name [e.g., @pb.com] if the parsed domain name has been prescribed with said remote e-mail correcting computer." Therefore, the present invention is particularly advantageous in that it provides e-mail messaging assistance for users that may have no idea of the recipients e-mail address but do know that the intended recipient has an e-mail account at a specified domain name (e.g., @pb.com).

With respect to the Tsuei patent, it teaches an email forwarding system that is operative to receive an undeliverable e-mail message and determine whether it has a forwarding e-mail address for the e-mail address associated with the aforesaid undeliverable e-mail message so the e-mail message may be appropriately forwarded. See for example, col. 7, lines 9-24 of the Tsuei patent. And if it does not have a forwarding e-mail address prescribed in its database, it indicates "this fact" to the user and thus provides no further assistance to the user in forwarding the undeliverable e-mail message. See for example, col. 7, lines 24-27 of the Tsuei patent.

The Reilly patent, like the Tsuei patent, teaches an email forwarding system in which a user requesting assistance must have prior knowledge of at least a now invalid e-mail address associated with an intended recipient. For instance, col. 8, lines 23-30 of Reilly explicitly states:

> Forwarding service 300 receives the request, which preferably includes the old e-mail address, and checks its database for any new address associated with the old e-mail address . . .

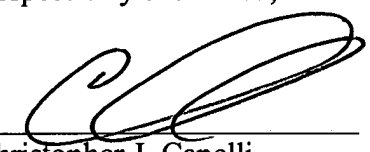
Thus, the Reilly patent, and just like the Tsuei patent, does not teach: "prescribing at least one domain e-mail address without a e-mail username [e.g., @pb.com]. . . [and] prescribing at least one e-mail address format message for e-mail messages" nor would it have any reason to do so as it only concerns providing a complete e-mail forwarding address to a user, which clearly requires an "e-mail username" being prescribed in its database.

Accordingly, for at least the above-explained reasons, it is respectfully submitted neither the Tsuei patent nor the Reilly patent, taken either alone or in combination with one another, teach Applicants invention as presently claimed. Therefore, it is submitted the subject 35 USC §103 rejection has been overcome and withdrawal thereof is warranted.

IV. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that pending claim1 is now in condition for allowance and favorable action thereon is requested. If the Examiner should have any questions, he is kindly urged to contact the undersigned attorney.

Respectfully submitted,



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